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VINSON & ELKINS L.L.P. 1001 FANNIN STREET 2300 FIRST CITY TOWER HOUSTON, TX 77002-6760			TUCKER, PHILIP C	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/501,559
Filing Date: February 09, 2000
Appellant(s): CHOWDHARY ET AL.

MAILED

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Randall C. Furlong
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/21/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-11, 27-32, 34-39 and 41-70 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,269,975	RUTENBERG et al.	5-1981
5,646,093	DINO	7-1997
5,990,052	HARRIS	11-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 2, 5-11, 27-30, 34-37, 41-66, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975).

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Moisture content and mesh size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. Rutenberg differs from the present invention in that the use of both

flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held , such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking.

Rutenberg also differs in not specifying an extruding barrel of 2 - 8 inches. The utility of barrels of differing size, in order to optimize the processing of the guar would be an obvious variation to one of ordinary skill in the art (In re Rose 105 USPQ 237).

Although Rutenberg does not teach the hydration rate properties at specific temperatures disclosed in claims 41-70, the mere discovery of a property of an obvious composition has been held to not alone render patentability by the courts. In re Dillon 16 USPQ2d 1897 states "but discovery that claimed composition possesses property not disclosed for prior art does not alone defeat a prima facie case, and it is not necessary, in order to establish prima facie case, to show both structural similarity between claimed and prior art compound and suggestion in, or expectation from, prior art that claimed compound will have the same or similar utility as one newly discovered by applicant". Thus applicants mere discovery of the property of hydration rates at specific temperatures does not render patentability to the composition.

2. Claims 1, 3, 4, 27, 31, 32, 34, 38 , 39, 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975) in view of Dino (5646093), Harris (5990052) and Applicants specification.

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Moisture content and mesh size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held , such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. Rutenberg differs in not teaching the use of chemically or genetically modified guar. The utility of chemically or genetically modified guar as an alternative to guar in the industrial uses disclosed by Rutenberg at column 1, lines 8-12 are well known, and would be obvious to one of ordinary skill in the art. In support of such knowledge in the art, Dino in Example 1, and Harris at column 8, lines 35-37 teach the use of guar splits to form chemically modified guar products which are used in operations such as oil well drilling

and fracturing. Dino further teaches at column 2, lines 31-41 that polygalactomannans such as guar and their derivatives are well known as thickeners in fluid systems. One of ordinary skill in the art would clearly be motivated to use the derivatized guar of Dino or Harris in the process of Rutenberg to obtain the improved viscosity characteristics therein. Applicants specification at page 9, lines 15-27 clearly teach that it is known in the art to chemically modify guar gum, and genetically modify plants in order to produce the guar products, thus such variations would be obvious variations to one of ordinary skill in the art.

Although Rutenberg does not teach the hydration rate properties at specific temperatures disclosed in claims 41-70, the mere discovery of a property of an obvious composition has been held to not alone render patentability by the courts. In re Dillon 16 USPQ2d 1897 states "but discovery that claimed composition possesses property not disclosed for prior art does not alone defeat a prima facie case, and it is not necessary, in order to establish prima facie case, to show both structural similarity between claimed and prior art compound and suggestion in, or expectation from, prior art that claimed compound will have the same or similar utility as one newly discovered by applicant". Thus applicants mere discovery of the property of hydration rates at specific temperatures does not render patentability to the composition.

(11) Response to Argument

Initially it is desired to point out to the Board of Appeals that the term "flattened" is the same as the "flaked" used in the present invention (see Rutenberg at column 5, line 68 – column 6, line 2). With respect to applicant's arguments that the combination of flaking and extruding is not obvious over Rutenberg, although Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed in a single process, the courts have held, such as in In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. One of ordinary skill in the art would expect that the extruding and flaking would have a cumulative effect. Contrary to applicant's assertion the flaking and extruding elements are clearly disclosed, and they are linked in view of the cited case law. A clear prima facie case has thus been made. Since both steps taught by Rutenberg are used to increase the viscosity of fluids containing the guar, the combination of such steps would be obvious to one of ordinary skill in the art in view of Crockett. Once a prima facie case of obviousness has been established, the burden shifts to the applicant to come forward with evidence to distinguish the invention (In re Biasecki 223 USPQ 785, In re Thorpe 227 USPQ 964). Applicant has not shown any superior and unexpected results from the teachings of the specification, an affidavit or declaration to show that the properties of the present product are superior and unexpected, over the properties of the extruded product of Rutenberg, which could render the teachings therein nonobvious. Applicant has only shown in the specification

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that nonextruded and nonflaked guar has inferior hydration properties to the guar of the present invention. Applicant's specification seems to indicate that the improvement achieved by the present process is by the step of extrusion. As such, a showing of superior and unexpected results would be necessary, to indicate that some unexpected or synergistic effect results from both steps of extrusion and flaking, compared to the extruded product of Rutenberg.

Applicant has argued that Rutenberg teaches away from the present invention, since Rutenberg teaches that the extruding step results in a superior product than the flaking step. However, Rutenberg does not disclose that the flaking and extruding are mutually exclusive, that detrimental effects would occur in combining the flaking and extruding steps, or that one process cannot be used in combination with the other. As such Rutenberg cannot be seen as teaching away from the combination of flaking and extruding. Clearly one of ordinary skill in the art would be motivated to take advantage of the cumulative effects of improved viscosity afforded by flaking and extruding, as taught by Rutenberg, over the nonflaked and nonextruded guar, instead of being led away by the teachings therein.

Applicant has argued that there is no motivation to modify the references. However, applicant has not given any reasons why such combination is improper. Applicants own specification at page 9, lines 15-27 indicates that one of ordinary skill in the art would clearly modify guar gums for use in the applications taught therein. Such is inclusive of well treatment fluids as taught by Dino and Harris. Dino further teaches at column 2, lines 31-41 that polygalactomannans such as guar and their derivatives are

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well known as thickeners in fluid systems. One of ordinary skill in the art would clearly be motivated to use the derivatized guar of Dino or Harris in the process of Rutenberg to obtain the improved viscosity characteristics therein.

Applicant has argued whether the use of In re Dillon is proper, since a method is claimed instead of a composition. Applicant is arguing that the improved hydration characteristics of the compound or composition, produced by the method, is distinguishing over the prior art. The utility of Dillon is proper, since the properties applicant seeks to be distinguishing are of the composition which is produced and not the process.


Applicant has further argued that the term "the powder disposed to hydrate faster than a corresponding powder made without the extruding step" is distinguishing. Since the powders disclosed by Rutenberg are made with an extruding step, it is not seen how such term would distinguish the current method, because such property would be obviously possessed by the powder of Rutenberg which undergoes the same extrusion step.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Art Unit 1712

PCT
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